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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/629,547	04/09/96	TAKAHASHI	T ATS-032-CON/
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EXAMINER

PM92/0224

FOLEY & LARDNER
3000 K. STREET N.W.
SUITE 500 P.O. BOX 25696
WASHINGTON DC 20007-8696

LUONG, V

ART UNIT

PAPER NUMBER

3682

DATE MAILED:

02/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/629,547

Applicant(s)

Takahashi et al.

Examiner

Vinh Luong

Group Art Unit

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☒ Responsive to communication(s) filed on 2/16/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12, 16, 28, 31, and 43-68 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-12 is/are allowed.

☒ Claim(s) 16, 28, 31, and 43-68 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 5/23 & 7/23/97 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/485,659.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 34

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Vinh T. Luong
Primary Examiner

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The Amendment filed on December 3, 1999 (Paper No. 33) has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 23, 1997 and July 23, 1997 have been approved by the examiner.
3. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. The drawing correction must comply with 37 C.F.R. 1.121(b)(3), e.g., any change to the patent drawings (Figs. 1 and 3) must be by way of a new sheet of drawings with the amended figures identified as "amended."
4. The Information Disclosure Citation (IDS) filed on December 8, 1999 has been considered. Although applicant did not submit an English translation, a search report, or an action which indicates the degree of relevance found by the foreign patent office, the examiner accepts applicant's brief description of JP 64-11453 and JP 58-151734 in the IDS as a concise explanation of the relevance, *as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information* under 37 C.F.R. 1.98(a)(3). Further, the examiner drew a line through other citations in the IDS because the other citations have been considered and cited in Form PTO-892 attached.
5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter such as "a *first* clearance" in claims 43 and 47. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

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6. Claims 16, 28, 31, 43-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term such as “movable” in claims 16 and 31 is vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, the first portion of the flywheel is axially movable, but is not required structurally to be axially moved with respect to the reinforcing member and the elastic plate. See “crimpable” and “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

It is unclear whether a confusing variety of terms such as: (1) “*a first portion* of said flywheel” in claims 16 and 31, “said elastic plate and said flywheel body comprise *a first portion*” in claims 43 and 47; and (2) “a first clearance” and “a free space” in claims 43 and 47, “a space” in claims 44 and 48, and “a clearance” in claim 57 refer to the same or different things. See M.P.E.P. 608.01(o). Applicant is respectfully urged to identify each claimed element with reference to the drawings.

The term such as “substantially” in claims 55 and 63 is a relative term which renders the claims indefinite. The term “substantially” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, *e.g.*, what range of the slope of the

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first surface relative to the engaging surface is required in order that the first surface is “substantially parallel” to the engaging surface.

7. Claims 16, 28, 31, and 43-68 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is well settled that a reissue application is not permitted to “recapture” claimed subject matter *deliberately* canceled in the original application. *In re Clement*, 45 U.S.P.Q. 1161 (CAFC 1997). See M.P.E.P. 1412.02. Note also that in *Hester v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone. Applicant *cannot* acquire, through reissue, claims that are the *same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection*.

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Regarding claim 16, lines 1-12 of claim 16 are copied from claim 16 of grand parent application Serial No. 07/485,659. However, claim 16 of SN'659 had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. On the other hand, the scope of lines 13-16 of claim 16 of this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 16 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection as set forth above.

Similarly, regarding claim 31, similarly, lines 1-11 of claim 31 are copied from claim 18 of parent application Serial No. 07/485,659. However, claim 18 of SN'659 had been rejected by the examiner and affirmed by the Board decision on January 5, 1994. On the other hand, the scope of lines 12-15 of claim 31 of this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 18 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection as set forth above.

Regarding claim 28, note that claim 28 is dependent upon claim 16 which is substantially copied from claim 16 of SN'659. Since claim 16 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture claim 16 of SN'659 by adding a limitation unrelated to the rejection.

New claims 43-68 are dependent upon claim 16 or 31. Therefore, new claims 43-68 add further limitations to claim 16 or 31, i.e., new claims 43-68 add further limitations unrelated to the

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rejection in SN'659. Consequently, new claims 43-68 are rejected under the recapture rule for adding further limitations unrelated to the rejection in SN'659 for the reason set forth above.

8. Claims 16, 28, 31, 46, 50-53, 60, 61 and 66, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Utility Model No. 64-11453 (Model'453) cited by applicant.

Regarding claim 16, Model'453 teaches a flywheel assembly comprising:

a crankshaft 3a;

an elastic plate 2 comprising an inner portion secured to a shaft end of the crankshaft;

a flywheel body 1 secured to the elastic plate 2 and having an engaging surface for engaging with a clutch disc 9, 10;

a reinforcing member 3b for reinforcing the plate 2 at the inner portion of the plate;

wherein the plate clamped axially between the reinforcing member 3b and the shaft end of the crankshaft 3a;

wherein a first portion of the flywheel is movable axially with respect to the reinforcing member or *vice versa* due to the vibration of the flywheel as seen in Figs. 2 and 6 of Model'453.

Note that the elastic plate of Model'453 inherently has an axial rigidity. In fact, virtually any structural material has an axial rigidity measured by, e.g., tensile stress and tensile strain, etc. In summary, Model'453 teaches the invention substantially as claimed. However, Model'453 does not explicitly teach the range of axial rigidity of the elastic plate such as 600 kg/mm to 2200 kg/mm.

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It is common knowledge in the art to choose the range of axial rigidity of the elastic plate of Model' 453 such as 600 kg/mm to 2200 kg/mm in order to improve the vibration absorption. See M.P.E.P. 2144.05 and the Board decision in SN' 659.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the range of axial rigidity of the elastic plate of Model' 453 such as 600 kg/mm to 2200 kg/mm in order to improve the vibration absorption as suggested by common knowledge in the art.

Regarding claims 28 and 31, similarly to claim 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the range of axial run-out of the engaging surface as claimed (i.e., no more than 0.1 mm) in order to improve the vibration absorption as suggested by common knowledge in the art.

Regarding claims 46, 50-52, 60, and 66, see regarding claims 16, 28, and 31 above.

Regarding claims 53 and 61, the plate of Model' 453 is clamped by a fastening means 5.

9. Claims 1-12 are allowed.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

11. Applicant's arguments filed December 3, 1999 (Paper No. 33) have been fully considered but they are not persuasive.

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The thrust of applicant's arguments is that the pending reissue claims 16 and 31 are broader in some aspects than claims 1 and 8 of U.S. Patent No. 5,465,635, however, these claims 16 and 31 are neither broader than nor essentially the same scope as the broadest claim canceled during prosecution of the original '635 patent.

The examiner does not dispute the fact that the pending reissue claims 16 and 31 are broader in some aspects than claims 1 and 8 of U.S. Patent No. 5,465,635. However, applicant's comparison of claims 16 and 31 with claims 1 and 8 of Pat.'635 is immaterial since claims 1 and 8 are plainly not canceled. The material issue is *whether the claims 16 and 31 of this reissue application are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection in SN'659.*

In the instant case, claims 16 and 31 copy claims 16 and 18 of SN'659 and add new limitations. The first added limitation "wherein said elastic plate is clamped axially between said reinforcing member and said shaft end of said crankshaft" is copied from claim 4 of Pat.'635. The second added limitation "wherein a first portion of said flywheel is axially *movable* with respect to said reinforcing member and said elastic plate" is vague and indefinite in the sense that things which may be done are not required to be done, thus, it apparently adds no substance. Since the added limitations are merely "*incidentally*" or "*inherent*" as seen in claim 4 of Pat.'635, they should not be considered as "material." *Mentor Corporation v. Colorplast*, 998 F.2d 992 (CAFC 1993).

On the other hand, a review of the prosecution history shows that claims 16 and 18 of SN'659 had been rejected by the examiner and affirmed by the Board decision on January 5, 1994. The copied

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part of the previously rejected claims *is the same in an aspect germane to a prior art rejection*. If applicant does not add new limitations, the copied part of claims 16 and 31 should be automatically rejected under the doctrine of *res judicata*. Although the new added limitations in claim 16 and 31 narrow the scope of the previously rejected claims 16 and 18 of SN'659, however, these new limitations are not only immaterial but also unrelated to the previous rejections of claims 16 and 18 of SN'659 based on Numata et al. (Japanese Patent Publication No. 57-058542).

Applicant averred, *inter alia*, that the added limitations "narrow the claims in any *material aspect* compared with their broadening," then the reissue claim is broader in a way that does not attempt to reclaim what was surrendered.

The examiner respectfully submits that applicant's contention is in direct conflict with the evidence presented in the record. In the case at hand, the added limitations do *not* "narrow the claims in any *material aspect* compared with their broadening" since the added limitations are already claimed in claim 4 of Pat.'635 and vague and indefinite. Claim 4 was allowed because it was dependent upon claim 1. It can be determined from examining the patented file that the examiner and/or the Board relied upon the limitations set forth in the "wherein" clause of claims 1, 8 and 9 of original application as defining over the prior art, thus making the original claims allowable, these limitations must be in the reissue claims in order to avoid the recapture rule.

Pursuant to the guidelines on page 4 of the Memorandum of the Office about Recapture Rule to Reissue Applications dated September 21, 1999, the narrow scope of the claims 1, 8 and 9 in the Pat.'635 is not an error within the meaning of 35 U.S.C. 251, therefore, the broader scope

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surrendered in the application SN'659 for the Pat.'635 cannot be recaptured by the filing of the present reissue application. The rejection based on 35 USC 251 is deemed to be proper, *a fortiori*, reiterated.

12. Applicant's amendments, e.g., in the last two lines of claims 16 and 31 and new claims 43-68 necessitated the new ground(s) of rejection under 35 USC 112, second paragraph, presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 3, 1999 prompted the new ground(s) of rejection under 35 USC 103 presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-7687. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been

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transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

February 22, 2000

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal flourish extending to the right.

Vinh T. Luong
Primary Examiner